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TROP PRUNER & HU, PC
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER
RAMAN, USHA

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Technology Center 2600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/766,125
Filing Date: January 19, 2001
Appellant(s): LOWTHERT ET AL.

Rhonda Sheldon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 21st, 2007 appealing from the Office

action mailed December 18th, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20010042249	Knepper et al.	11-2001
20020100041	Rosenberg et al.	7-2002
6,698,020	Zigmond et al.	2-2004

Rosenberg (US Provisional Application 60/240714), filed on October 15th, 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 62, 63, 65, 66, 69-74, 77, and 79-90 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Knepper et al. (US Pre Grant Pub. 2001/0042249) in view of

Rosenberg et al. (US PG Pub. 2002/0100041).

In regards to claim 62, Knepper discloses a system comprising:

A transmitter to transmit an info segment (instruction set) including a content

identifier (showed/SID, EID, a show name, see example instruction sets in [0064],

[0078], [0079]) to specify one particular content item (entertainment media such as

movie or a show), the info segment also including an interruption point specifier

(EADOK, EMAXAD tags) that causes the display of an advertisement to replace the

display of the one particular content item (advertisements are placed within a show

according to rules set forth in the instruction set, therefore the display of the "show"

is replaced with display of the advertisement, see Knepper: [0080] and [0081]), such

that the place in the content where the replacement might happen during use of the

one particular content item is not known (see Knepper: [0080]: "it may be allowed for

ads to be placed randomly within a show", [0082]: "the tags allow for *real time*

determination of advertisement content", [0084]: "the location of advertisement

media files within a show maybe determined by various criteria at the time of the

playback").

A storage (105) to store the info segment (instruction set) until the info segment is transmitted to a receiver. See Knepper: [0026].

Knepper accordingly shows random placement of advertisements within a particular show, such that a specific advertisement is to be played to replace the display of the content is known. Knepper however is silent on dynamic placement of advertisements in content such that when the replacement of content might happen is not known prior to the use of the content.

In a similar field of endeavor, Rosenberg discloses the step of detecting a condition during user playback of stored content, (the condition being a pause function), upon the occurrence of which, an ad is displayed to the user. The ad placement is therefore dynamic and not predetermined because it is based on user playback controls (in this case pause), which is not known ahead of time. The Rosenberg reference incorporates by reference provisional application (US 60/240,714) that provides support for the aforementioned step, in pages 8, lines 25-26 and lines 28-29: "the *pause function* displays an ad a predetermined period of time after the pause occurs", such that "the user no longer sees the paused content and begins seeing the ad".

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper in view of Rosenberg's teachings by displaying an ad to the user when the user has paused the content item, thereby drawing the user's attention towards the ad, when user's attention is away from the content item.

In regards to claim 63, Knepper discloses that the storage stores an info segment (see example of instruction set in [0079]) including a plurality of fields, one field comprising said interruption point specifier (EADOK tags that when included in the instruction set dictate whether or not ads to be are enabled during the show, therefore dictate whether or not the playback of the content maybe interrupted by the ad and EADMAX tags set the number of ads that may interrupt the content, see [0080], [0081]), another field selected from the group consisting of a permitted ad type specifier (CPCLSI tags are "a positive association tag", see [0081]: "would indicate any category of content that the content provider would allow or requires to be associated with a show"), and a prohibited ad type specifier (CPCLSE tags are "negative association tag", see [0081]: "would indicate any category of content that a content provider would indicate as unacceptable for advertisement within a show"); and

The transmitter transmits info segment separately from the content item (the media files and instruction set are separate files and therefore transmitted as separate files from the server to the client; see [0008] and [0009]: "media files are downloaded from a server to a client and pre-cached at the client side" and "an instruction set which resides within a text file is also downloaded from the server to the client").

In regards to claim 65, while Knepper discloses that media files maybe delivered to the user over a variety of communications networks other than the Internet (see [0092]: "The invention is not limited to being used for entertainment and

advertisement media files across the Internet, rather, the invention may be used for

different types of files across a wide variety of communications networks"), Knepper

is silent that the system can be a television broadcaster.

Examiner takes Official Notice[1] that is well known to delivery media files over

a television network by television broadcaster.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system of Knepper by transmitting media files over a

television broadcast network, thereby providing desired media and targeted

advertisements to television viewers.

In regards to claim 66, the transmitter (server) transmits the info segment

("instruction set" for correlating advertisements with media programs) to the receiver

upon request (see Knepper [0026]: "a user requests a show"...."the request also

triggers delivery of an appropriate instruction set").

In regards to claim 68, the Knepper discloses that the server creates an info

segment specific to each user (see [0034]). The modified system therefore

comprises the step of an info segment generator at the server for generating the

instruction set comprising the plurality of fields, including a content identifier (show

name, ShowID/SID, EID, see example instruction sets in [0078] and [0079]) and an

interruption point specifier (EADOK, EADMAX tags, see [0080], [0081]).

In regards to claim 69, Knepper discloses an info segment generator to insert

an interruption point specifier as discussed in claim 68 above. The instruction

generator further generates other fields selected from the group consisting of a

permitted ad type specifier (CPCLSI tags are "a positive association tag", see [0081]:

"would indicate any category of content that the content provider would allow or

requires to be associated with a show"), and a prohibited ad type specifier (CPCLSE

tags are "negative association tag", see [0081]: "would indicate any category of

content that a content provider would indicate as unacceptable for advertisement

within a show") in the instruction set. It is noted that tags such as EADMAX,

EADOK, CPCLSI, CPCLSE are all associated with various aspects of advertisement

to be included with the show, and therefore are the "ad entry parameters" in the

instruction set.

In regards to claim 70, the system receives at the receiver (i.e. the client 203)

the info segment from an external source (i.e. server 207). See Knepper: [0034]

In regards to claim 71, Knepper discloses a method comprising:

Associating one info segment "instruction set" with one particular content item

(e.g. movie or a show). When the user places a request for a movie or a show, the

appropriate instruction set is also delivered to the user (see [0026]). Knepper

therefore shows the step of associating the appropriate instruction set with the

requested show.

Associating the interruption point indicator (inclusion of EADOK, EMAXAD

tags associates the interruption point indicator with the instruction set) with the one

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[1] Support for this Official Notice can be found in Zigmond column 7, lines 16-21, column 12, lines 1-3, and column 15, lines 11-16]

info segment, the interruption point indicator will cause an advertisement to be displayed in place of the one particular program content item (advertisements are placed within a show according to rules set forth in the instruction set, therefore the display of the "show" is replaced with display of the advertisement, see Knepper: [0080] and [0081]), the placement of a particular advertisement during playback of the content is not predetermined (see Knepper: [0080]: "it may be allowed for ads to be placed randomly within a show", [0082]: "the tags allow for *real time* determination of advertisement content", [0084]: "the location of advertisement media files within a show maybe determined by various criteria at the time of the playback") when the interruption point indicator is associated with the info segment.

Delivering the info segment comprising the interruption point indicator (i.e. therefore together) to a receiver (see [0026]).

Knepper is silent on the steps of the interruption point indicator to indicate a condition upon whose satisfaction will cause the placement of the advertisement, wherein the placement of *any* advertisement due to the satisfaction of the condition is not predetermined when the interruption point indicator is associated with the info segment.

In a similar field of endeavor, Rosenberg discloses the step of detecting a condition during user playback of stored content, (the condition being a pause function), upon the occurrence of which, an ad is displayed to the user. The Rosenberg reference incorporates by reference provisional application (US 60/240,714) that provides support for the aforementioned step, in pages 8, lines 25-

26 and lines 28-29: "the *pause function* displays an ad a predetermined period of time after the pause occurs", such that "the user no longer sees the paused content and begins seeing the ad". Rosenberg discloses the use of a pause ad "AD_type" rule in the ad control file. See Rosenberg '714 provisional application, page 12, lines 1-3 and page 18, lines 4-6. Because this rule specifies the condition upon which ads must be played instead of the content, the rule is an interruption point specifier. The *placement* of any advertisements in the content is not predetermined when the instruction set was specified because it is not known when the user will enter a 'pause' function. The placement of the advertisement is therefore dynamic based on user playback operations.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper in view of Rosenberg by further including an pause ad interruption type specifier for displaying an ad to the user when the user has paused the content item, thereby drawing the user's attention towards the ad, when user's attention is away from the content item.

In regards to claim 72, the instruction set further includes a content identifier (showed/SID, EID, a show name, see example instruction sets in [0064], [0078], [0079]) to specify one particular content item (entertainment media such as movie or a show) with which the info segment is associated (when the user places a request for the show, the set instruction associated with it is also delivered to the user, see [0026]).

In regards to claim 73, Knepper discloses an info segment generator to insert an interruption point specifier as discussed in claim 68 above. The instruction generator further generates other fields selected from the group consisting of a permitted ad type specifier (CPCLSI tags are "a positive association tag", see [0081]: "would indicate any category of content that the content provider would allow or requires to be associated with a show"), and a prohibited ad type specifier (CPCLSE tags are "negative association tag", see [0081]: "would indicate any category of content that a content provider would indicate as unacceptable for advertisement within a show") in the instruction set. It is noted that tags such as EADMAX, EADOK, CPCLSI, CPCLSE are all associated with various aspects of advertisement to be included with the show, and therefore are the "ad entry parameters" in the instruction set.

In regards to claims 74, the transmitter (server) transmits the info segment ("instruction set" for correlating advertisements with media programs) to the receiver upon request from a receiver (see Knepper [0026]: "a user requests a show"...."the request also triggers delivery of an appropriate instruction set"), wherein the info segment is transmitted as a separate entity from the content item and the advertisement files (the media files and instruction set are separate files and therefore transmitted as separate files from the server to the client; see [0008] and [0009]: "media files are downloaded from a server to a client and pre-cached at the client side" and "an instruction set which resides within a text file is also downloaded from the server to the client").

In regards to claim 77, Knepper discloses delivering the instruction set over a computer network, particularly the Internet, which is a packet switched network. See abstract, [0002].

In regards to claim 79, Knepper discloses a computer readable medium storing instructions that are executed to enable a system (server 207) to:

Associating one info segment "instruction set" with one particular content item (e.g. movie or a show). When the user places a request for a movie or a show, the appropriate instruction set is also delivered to the user (see [0026]). Knepper therefore shows the step of associating the appropriate instruction set with the requested show.

Associating the interruption point indicator (inclusion of EADOK, EMAXAD tags associates the interruption point indicator with the instruction set) with the one info segment, the interruption point indicator will cause an advertisement to be displayed in place of the one particular program content item (advertisements are placed within a show according to rules set forth in the instruction set, therefore the display of the "show" is replaced with display of the advertisement, see Knepper: [0080] and [0081]), the placement of a particular advertisement during playback of the content is not predetermined (see Knepper: [0080]: "it may be allowed for ads to be placed randomly within a show", [0082]: "the tags allow for *real time* determination of advertisement content", [0084]: "the location of advertisement media files within a show maybe determined by various criteria at the time of the playback") when the interruption point indicator is associated with the info segment.

Knepper discloses that in order for advertisements to be played, the EADOK flag

has to be set to true, and EADMAX has to be greater than 0 (see [0080, 0081].

During playback of a content when the detection of EADOK being true and EADMAX

greater than 0, will cause an advertisement to be displayed and when neither

condition are detected (i.e. EADOK not true or EADMAX not greater than 0), then no

advertisement will be displayed.

Delivering the info segment comprising the interruption point indicator (i.e.

therefore together) to a receiver (see [0026]).

Knepper is silent on the steps of the interruption point indicator indicating a

condition that is detectable during use of the content such that, the point at which

any advertisement is displayed due to detection of the condition is unknown prior to

the use of the content item.

In a similar field of endeavor, Rosenberg discloses the step of detecting a

condition during user playback of stored content, (the condition being a pause

function), upon the occurrence of which, an ad is displayed to the user. The

Rosenberg reference incorporates by reference provisional application (US

60/240,714) that provides support for the aforementioned step, in pages 8, lines 25-

26 and lines 28-29: "the *pause function* displays an ad a predetermined period of

time after the pause occurs", such that "the user no longer sees the paused content

and begins seeing the ad". Rosenberg discloses the use of a pause ad "AD_type"

rule in the ad control file. See Rosenberg '714 provisional application, page 12, lines

1-3 and page 18, lines 4-6. Because this rule specifies conditions upon which ads

may be played instead of the content, the rule is an interruption point indicator. The

placement of any advertisements in the content is not predetermined when the

instruction set was specified because it is not known when the user will enter a

'pause' function. It is also noted that, because "pause" ads, display the ad after a

predetermined time after the user enters a pause state, the pause ad is not

displayed if the user does not enter a paused state. The placement of the

advertisement is therefore dynamic based on user playback operations.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system of Knepper in view of Rosenberg by further including

an pause ad interruption type specifier for displaying an ad to the user when the user

has paused the content item, thereby drawing the user's attention towards the ad,

when user's attention is away from the content item.

In regards to claim 80, the instruction set created by the server (see Knepper:

[0034]) further includes a content identifier (showed/SID, EID, a show name, see

example instruction sets in [0064], [0078], [0079]) to specify one particular content

item (entertainment media such as movie or a show) with which the info segment is

associated (when the user places a request for the show, the set instruction

associated with it is also delivered to the user, see [0026]).

In regards to claim 81, Knepper discloses an info segment generator to insert

an interruption point specifier as discussed in claim 68 above. The instruction

generator further generates other fields selected from the group consisting of a

permitted ad type specifier (CPCLSI tags are "a positive association tag", see [0081]:

"would indicate any category of content that the content provider would allow or requires to be associated with a show"), and a prohibited ad type specifier (CPCLSE tags are "negative association tag", see [0081]: "would indicate any category of content that a content provider would indicate as unacceptable for advertisement within a show") in the instruction set. It is noted that tags such as EADMAX, EADOK, CPCLSI, CPCLSE are all associated with various aspects of advertisement to be included with the show, and therefore are the "ad entry parameters" in the instruction set.

In regards to claim 82, the transmitter (server) transmits the info segment ("instruction set" for correlating advertisements with media programs) to the receiver upon request (see Knepper [0026]: "a user requests a show"...."the request also triggers delivery of an appropriate instruction set").

With regards to claim 83, Knepper discloses that instructions maybe downloaded from server to client preferably upon request from the user. See [0011]. Knepper however does not disclose that the server uses a push method to download the info segment to the receiver.

Examiner takes Official Notice[2] that it was well known for servers to push data files to client systems for client access files when they're off line.

It would have been obvious to further modify the system by pushing the data from the server to the client so that the client can access the instruction set during offline times.

With regards to claim 84, Knepper discloses that a wide variety communications networks maybe used for delivering the various data files. See [0092].

While the system doesn't specifically disclose using airwave for transmission of the instruction set, the examiner takes Official Notice[3] that transmission of media content over airwaves were well known in the art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by distributing the plurality of data over airwave, so that the advertisements can be targeted to users receiving television broadcast over airwave.

With regards to claim 85, Knepper discloses that the communications method over which the instruction set is received is over the Internet, which is a packet switched network. See [0014].

With regards to claim 86, Knepper discloses that the instruction set is downloaded from server storage to the client and stored on the client's hard disk until the user requests playback. See [0028]. Knepper is silent on the step of storing instruction set on a transferable recordable medium.

Examiner takes Official Notice[4] that it was well known at the time of the invention to write data on a transferable recordable medium, and deliver the recordable medium to the user.

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[2] Support for this Official Notice can be found in Knepper paragraphs [0033]-[0034], where content is automatically downloaded from server to client without user interaction.
[3] Support for this Official Notice can be found in Zigmond column 7, lines 16-21, column 12, lines 1-3, and column 15, lines 11-16]

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system by writing the data, including the instruction set on a

transferable recordable medium, and delivering the recordable medium to the user.

The motivation is to target advertisements to consumers of the recorded medium.

With regards to claims 87, 88, and 90, the interruption point specifier identifies

a play specific condition such as a user-initiated pause with info segment (i.e. pause

ad, see Rosenberg provisional application '714, page 18, lines 4-6 and page 8, lines

25-27).

With regards to claim 89, the system is a server computer. See Knepper:

[0029].

Claims 64, 67, 75-76 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Knepper et al. (US Pat. 2001/0042249) in view of Rosenberg et al. (US PG Pub.

2002/0100041) and further in view of Zigmond et al. (US Pat. 6,698,020).

In regards to claim 64, Knepper discloses the step of downloading multiple

series/shows (see [0028], [0036]) and downloading instruction sets associated with

the plurality of shows (see [0026]). The plurality of instruction sets further have

content identifier (show name, ShowID, EID) that identify the content it is associated

with. Knepper is however silent on the method of cataloguing the shows having a

program ID and associating them with an information segment.

Zigmond discloses storing an EPG at the subscriber premises cataloguing a

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[4] Support for this Official Notice can be found in Zigmond column 7, lines 7-12, wherein one of the content
delivery channel is videotape. Knepper further shows storing instruction set so that it is available when a
user plays back the content (see [0028])

plurality of programs having a program identifier (see Zigmond: column 10, lines 64-67, column 11 lines 1-2 and lines 45-46). The EPG in conjunction program identifier is used for ad selection for targeting appropriate ads.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper by storing an EPG displaying programs having a content identifier at the user premises and utilizing it to associate the instruction set with a user selected program for display of targeted ads. The motivation is to providing a cataloged listing of a plurality of programs to the user to aid the user in making a request for viewing.

In regards to claims 67, and 75, Knepper does not disclose that the transmitter transmits info to the receiver without request.

Zigmond discloses the step of transmitting info segment (containing ad rules for targeting) that are transmitted to the receiver without request. See Zigmond: column 12, lines 1-14.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper to include the mechanism of "pushing" the info segment to the receiver, thereby providing up to date ad selection rules for enabling the targeting of advertisements to television audiences.

In regards to claim 76, Knepper discloses the step of delivering the instruction set over communications network (see [0092]), however is silent on delivering the info segment over airwaves.

Zigmond discloses delivering the info segment (ad selection criteria)
advertisement delivery channels, including broadcast signals (i.e. airwave). See
Zigmond: column 12, lines 1-9 and column 15, lines 11-16.

It would have been obvious to one of ordinary skill at the time of the invention
to modify the system in view of Zigmond by delivering the info segment over the
airwaves thereby delivering it to broadcast television viewers.

In regards to claims 78, Knepper is silent on delivering the info segment on a
recordable medium.

Zigmond discloses delivering pre-installed ad selection criteria in ad insertion
devices (and therefore are recorded onto the devices on a recordable medium). See
Zigmond: column 12, lines 6-12.

It would have been obvious to one of ordinary skill in the art at the time of the
invention to modify the system by delivering the info segment on a recordable
medium as taught by Zigmond, thereby enabling targeted advertisements for
programs in a recordable medium.

(10) Response to Argument

The examiner respectfully disagrees that the rejection should be reversed. Only
those arguments having been raised are being considered and addressed in the
Examiner's Answer. Any further arguments regarding other elements or limitations not
specifically argued or any other reasoning regarding deficiencies in a prima facie case
of obviousness that the appellant could have made are considered by the examiner as
having been conceded by the appellant for the basis of decision of this appeal. They

are not being addressed by the examiner for the Board's consideration. Should the panel find that the examiner's position/arguments or any aspect of the rejection is not sufficiently clear or a particular issue is of need of further explanation, it is respectfully requested that the case be remanded to the examiner for further explanation prior to the rendering of a decision. See 37 CFR 41.50(a)(1) and MPEP 1211.

Appellant argues (see Brief page 14) that Knepper does not teach "the place in the content where the replacement might occur *during* content is unknown" because "the exact placement of the advertisement is predetermined so that the files can be properly assembled per the modified instruction set before the show is played back". The examiner disagrees with this assertion for several reasons. First, examiner would like to point out to the Panel that, claim 62 language recites, "*prior to a use* of the particular content item, the place in the content where the replacement might happen, as a result of the detection of the condition during use of said one particular content item, is not known". The claim language therefore suggests that the place in content where the replacement might happen is not known *prior to use* of the content item, not "*during the use of the content*" as argued by the appellant in page 13 of the Brief. The examiner further disagrees with appellant's arguments because Knepper discloses that advertisements maybe placed randomly within a show (see [0080]). For example, the step of playing a *specific* advertisement (e.g. brand A soft drink advertisement) to replace the display of the content, wherein when during the duration of the show that *specific* advertisement will play may not known ahead of time, due to random placement. Knepper also discloses that, "the *location* of advertisement media files

within a show maybe determined by various criteria *at the time of playback"*.

Additionally, Knepper discloses that real-time alterations (i.e. during playback) may be

made to the instruction set affecting playback of a show (see [0082]: "the client will

make a *real time* amendment to the instruction set, altering the requirement for

permissible advertisement media files within the *remainder* of that show". When real

time modifications are made by the user as content is being played, the locations at

which modified advertisements maybe played were not known prior to playing of the

content. Furthermore, the examiner also notes that the scope of claim 62 is broader

than the scope considered during the prosecution of the instant application and

therefore it is believed, that Knepper fully anticipates the limitations of claim 62 the

reasons stated above. However the rejection of record for claim 62 further cites

Rosenberg for the teaching of dynamic placement of ads when user pauses a content,

i.e. when a user pauses a content is not known, and therefore the placement of 'pause'

ads are not known prior to playback of the content. It is therefore submitted that the

modified system of Knepper in view of Rosenberg also teach all the elements of claim

62, including replacing the content with an advertisement where the place in the content

where the replacement might occur *prior to use* of the content is unknown.

Appellant argues (see Brief, pages 14-15) that, "Knepper does not teach the

claimed interruption point specifier" because the "EADOK and EADMAX tags are meta

tags in a "show section" of an HTML instruction set that indicate whether advertisement

media files are allowed in the show and the maximum number of ads that can appear in

the show respectively" and concludes that the tags "do not actually cause an

advertisement to be inserted into a show". The examiner respectfully disagrees. When

the EADOK tag is true, it *enables* advertisements to played with during the show.

Furthermore, EMAXAD tag indicates the maximum number of advertisement files that

maybe played during the show. In order for the display of the show to be replaced by

the display of advertisements, both these flags must be enabled, i.e. disabling either of

these tags (i.e. EADOK = false or EMAXAD = 0) will result in no advertisements being

displayed during the play content, and therefore no content interruptions. Therefore it

can be seen that the EADOK and EMAXAD tags to in fact *cause* insertion of

advertisements during the playback of a show.

Appellant challenges (see Brief, page 15) the validity of the Rosenberg reference

stating that, "[Rosenberg] does not appear to have support in the provisional

applications from which it claims priority". Rosenberg was relied upon for the teaching

of detecting a pause condition during playback, upon the occurrence of which, an ad is

displayed to the user. The Rosenberg reference incorporates by reference provisional

application (US 60/240,714) that provides support for the aforementioned step, in pages

8, lines 25-26 and lines 28-29: "the *pause function* displays an ad a predetermined

period of time after the pause occurs", such that "the user no longer sees the paused

content and begins seeing the ad". Furthermore, appellant's arguments (see Brief,

page 15) stating that, "Rosenberg is specific in his provision applications that any ad

that appears upon pressing Pause is a static bit map" appears to be irrelevant as

Rosenberg is mainly relied upon for the teaching of a context-based ad placement and

not for the media format of the ad itself. Appellant's traversal (see Brief page 16) on

rejection of claim 79 is hinged on applicability of Rosenberg as a valid prior art.

However as stated above, Rosenberg provides support in the provision application '714

for pause function ads. It is also noted that, because "pause" ads, display the ad after a

predetermined time after the user enters a pause state, the pause ad is not displayed if

the user does not enter a paused state. The placement of the advertisement is

therefore dynamic based on user playback operations. For the reasons discussed

above, appellants arguments (see page 18) regarding claim 87 are also found

unpersuasive, as Rosenberg specifically discloses a play specific (i.e. pause)

interruption condition.

Appellant argues (see Brief, page 16) with respect to the rejection of claim 63

that, "neither the cited ratings nor the cited associations are fields within Kneppers

instruction set". The examiner inadvertently cited the wrong paragraphs from Knepper

in the final rejection of the claim. Knepper does however teach the recited limitations

instruction set with a plurality of fields including a permitted ad type specifier and a

prohibited ad type specifier through the use of CPI tags. For example, Knepper

discloses CPCLSI and CPCLSE tags in the instruction set, wherein CPCLSI tags are a

positive association tag (i.e. permitted ad type specifier), that "would indicate any

category of content that the content provider would allow or requires to be associated

with a show" (see [0081]), and CPCLSE tags are "negative association tag" (are a

prohibited ad type specifier), that, "would indicate any category of content that a content

provider would indicate as unacceptable for advertisement within a show". With further

regards to appellant's arguments (see Brief page 17) with respect to limitations of "ad

entry generator" of claim 69, Knepper shows creating an instruction set at the time of

user's request and specific to each user (see [0034]) and therefore teaches the step of

generating the plurality of instructions of the instruction set.

Appellant traverses (see Brief pages 17, 19, 20) with respect to claims 65, 86,

76, and 78, regarding the modification of Knepper to utilize a television broadcaster to

deliver the media files to television users, arguing that, "Knepper teaches away from

such a modification" because "Knepper is specifically directed to providing alternatives

to traditional streaming method especially over the Internet so that media files can be

downloaded from a server to a client". Appellant's characterizations of Knepper are

however mischaracterized because appellant has taken Knepper's "alternatives to"

streaming out of context. Knepper provides alternatives to traditional streaming

because quality of playback of a streaming media can suffer with slow Internet

connections, resulting in choppy unreliable playback of audio (see [0005]). The solution

provided by Knepper is to pre-cache media content at the user device, where all the

data files are available at the client side when the user plays back the content. Even

though Knepper teaches the illustrative embodiment as downloading data over the

Internet, Knepper clearly discloses that the invention maybe used with wide variety of

communication networks maybe for obtaining the data files. Accordingly, the

advantages of Knepper's inventions can be realized in a television broadcast system,

where media programs, advertisements and instruction sets maybe recorded (e.g. on a

transferable recordable medium) by the user's system (i.e. "pre-cached") and

assembled for playback at a later time according to the instructions set forth in the

instruction set.

Appellant's arguments (see Brief, page 10) with respect to claim 64 stating that,

"there is no indication that the information in database 81 is used to construct an EPG

such that a user could select a program for viewing from the guide". The examiner

recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves

or *in the knowledge generally available to one of ordinary skill in the art*. In this case,

Zigmond teaches an EPG containing program information for a plurality of programs

and it is notoriously well known in the art to utilize an EPG for cataloging programs for

aiding in user selection. Accordingly it is submitted that Knepper in view of Rosenberg

and Zigmond teaches all the elements of claim 64.

Appellant traverses (see Brief page 19) the teaching from Zigmond on

transmitting ad rules without request used for claim 67, stating that, "this logic is the

result of inappropriate hindsight reasoning" and that, "it is not clear why one of ordinary

skill in the art would be motivated to modify Knepper to push his instruction set for the

same reason [targeting ads]". Even though Zigmond has been relied upon in the

rejection of this claim, Knepper shows automatically downloading shows (after initial

subscription request) associated with the subscription without any client interaction.

The content is automatically delivered to the client when it becomes available, and an

instruction set is delivered with the content. See [0032]-[0034]. Knepper therefore

shows the step of pushing content from server to the client as well as instruction set

associated with those contents.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Usha Raman

Christopher Kelley

Supervisory Patent Examiner

CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Vivek Srivastava

Supervisory Patent Examiner

VIVEK SRIVASTAVA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600